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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,594	09/05/2001	Phillip M. Ginsberg	CF/047	1177

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FISH & NEAVE IP GROUP  
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1211 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036-8704

EXAMINER
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GREENE, DANIEL LAWSON

ART UNIT	PAPER NUMBER
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3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
30 DAYS	04/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

***Response to Amendment***

1. The response received 1/29/2007 setting forth the cancellation of claims 1, 3, 5, adding claims 16-32 and the election of Species 1b, 2e from the requirement for Election/Restriction mailed 1/17/2007 is acknowledged. However it is noted that Applicant has switched inventions, improperly elected from sections 3 and 4 of said requirement AND failed to provide a listing of which claims including which of the newly added claims, if any, read on the elected species.

2. Therefore, the reply filed on 1/29/2007 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): (See 37 CFR 1.111.)

3. Applicant has amended the claims such that they are no longer drawn to the originally acted upon invention. That is, the originally acted upon claims were drawn to a method for determining "excess profits" while the newly presented claims are simply drawn to a method comprising the steps of, among other things, distribution of "at least a portion of profits earned because of the deviation of the price of the outlier-price trade from the benchmark price." It is not considered that the current wording of the claims connotes the same meaning as the originally presented claims otherwise applicant would not have changed the wording.

4. Further, Applicant has failed to properly elect from the previous Requirement for Election/restriction mailed 1/17/2007. Applicants remarks received 1/29/2007 allege that the Examiner has provided an incomplete election requirement and has not proven a serious burden to examine the multitude of species set forth in the application. This is not persuasive as applicant's multitude of species does indeed present a serious

burden on the Examiner because, for example, each species requires a different search as well as different criteria of examination. In said Election requirement the Examiner already set forth how the species are considered to be independent, again the species do NOT appear to be obvious variants and they have materially different considerations and the search and examination of each species would indeed be a serious burden.

5. As set forth in section 10 of said Election requirement, if applicant were to simply admit on the record which species (set forth in said requirement) are obvious variants, then the restriction requirement in (only) that regard will be withdrawn.

6. On page 8 of said remarks, Applicant alleges that no requirement for election restriction is raised in sections 3 and 4 of said election requirement. It is the Examiners position that the myriad of trading prices and determinations of excess profits set forth an undue burden upon the Examiner to search and examine the multitude of ways Applicant may arrive at the claimed invention: As the Examiner set forth in said requirement "This additional requirement is to facilitate examining due to the broad range of (trading prices/items and values and prices) available to be (determined/monitored)". Again, Applicant has placed an undue burden upon the Examiner to search and examine ALL of the species set forth.

7. On said page 8, Applicant elected "The "[exact] trading price ... being monitored" elected for search is a synthetic price formed by taking a Gaussian-weighted average of the sum of three times the minute-by-minute sample variances of price above (or below) the higher (or lower) of the mode or median of the prices at which trades were executed during the respective minute, for a time window extending 17 minutes before and after

the trade in question, for oil futures trade on the Shanghai Futures Exchange. The "single species of exactly what the excess profits determination consists of" elected for search is the amount by which the execution price exceeds (or falls below) this synthetic price, convolved with the trade volume for all trades that exceeded (or fell below) the synthetic price during the 34-minute window." and then stated "No claim now pending recites a limitation excluding such embodiments, and thus all claims are readable on the elected "price" and "excess profits."

First, Applicant's election is nonresponsive in that it is not seen wherein the application as filed set forth such an invention to elect and therefore said attempted election is improperly drawn to "new matter",

Second, it is immaterial whether or not the claims recite the limitation excluding such embodiments. The Examiner did not require applicant to amend or cancel any claims. The Examiner only required applicant to specifically and distinctly choose ONE invention to be examined. For applicant's convenience, resort may be had to any of :

- a. 35 U.S.C. 121. "Divisional applications. If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions",
- b. 37 CFR 1.142. "Requirement for restriction. (a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being

called a requirement for restriction (also known as a requirement for division).

Such requirement will normally be made before any action on the merits;

however, it may be made at any time before final action. (b) Claims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled", or

c. 35 U.S.C. 101. "Inventions Patentable. Whoever invents or discovers any (meaning ONE) new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a (meaning ONE) patent therefor..."

in support of the Examiners requirements for election and restriction to ONLY ONE INVENTION to be examined. Again, applicant is invited to admit on the record which species are obvious variants.


8. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).


9. In order to comply with this notice of non-responsive amendment, applicant must comply with each and every requirement in said previous Office action to include in the least;

- a. Amend the currently pending claims such that they read on the previously acted upon invention, or clearly admit that the currently pending claims are obvious variants thereto,
  - b. Set forth the precise species to be examined per sections 3 and 4 of the previous Election/Restriction mailed 1/17/2007. Again, applicants response must be closed ended, that is to set forth ONE invention. An open ended election in response to this requirement will NO LONGER BE CONSIDERED INADVERTANT and applicant will be NOT be given a new response date, that is, failure to properly respond to each and every requirement set forth in this notice will be considered deliberate and the response date of future correspondences to reconcile said deficiencies will be considered from the mailing date of this correspondence, AND
  - c. provide a listing of all claims readable upon the finally elected species, for example ONLY, a statement such as "Claims 2-4, 6, 9 and 22 read on the elected species".
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene Jr. whose telephone number is (571) 272-6876. The examiner can normally be reached on Mon-Fri 8:30am - 5pm.
- If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3694

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DIG   
2007-04-09

  
ELLA COLBERT  
PRIMARY EXAMINER